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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,922	11/20/2001	James E. Satloff	SATLOFF 202-KFM	7797

7590

05/29/2003

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EXAMINER

LAYNO, BENJAMIN

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 05/29/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

EE

Office Action Summary	Application No.	Applicant(s)	
	10/005,922	SATLOFF ET AL.	
	Examiner	Art Unit	
	Benjamin H. Layno	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1-20 are rejected under 35 U.S.C. 102(a) as being **clearly anticipated** by Pinto et al.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 7-9, 12-14 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Mero et al.

The patent to Mero et al. discloses a method of playing a game using a plurality of trading cards, see Fig. 13. The game comprises a set of 708 trading cards, col. 8, lines 36-37 which are offered for sale, col. 8, lines 42-46. Each card has associated therewith a unique identifier of alphanumeric characters and represented as a barcode 87, Fig. 13. Each card also has a plurality of designated game related features 81-85 which include fictitious persons or creatures 81 and 85, and game events 83 and 84. Collectors select cards and build their own deck of cards forming a subset of cards for play in any given game, col. 9, lines 27-28. The subset of cards is registered with a

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game service provider on the internet, col. 8, lines 51-57. Once a card is registered, the card is placed in play and no other player will be able to enter or use that card unless it is first removed from the database. Thus, when a collector registers a subset of trading cards the game playing rights of the subset of cards are sold to that collector, col. 8, lines 58-62.

In regard to claim 1 (d)-(f), Mero et al. further comprises additional booster packs (additional special release cards) which may be purchased to supplement and enhance a player's "aura arsenal", thereby increasing or advancing the status of a game between collectors, col. 8, lines 43-47 and col. 9, lines 25-28. Also, cards can be swapped or won in an attempt to improve the chances of winning, col. 8, lines 33-34.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 6 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mero et al.

Mero et al. recites a total of 708 cards. However, Mero et al. further recites that additional booster packs (additional special release cards) may be purchased. Thus, it is inherent that the total number of cards may be at least 1000 in order to add more variety to Mero's game.

Claim 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Mero et al. as applied to claim 1 above, and further in view of Pearson et al.

The patent to Pearson et al. teaches that it is well known in the trading card art to represent a unique identifier on a trading card as a magnetic stripe col. 2, lines 44-47. In view of such teaching, it would have been obvious to substitute for Mero's barcode, a magnetic stripe in order to more conveniently register a trading card.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mero et al. as applied to claim 1 above, and further in view of Fernandes.

The patent to Fernandes teaches that it is well known in the trading card art to represent a unique identifier on a trading card as a microchip. In view of such teaching, it would have been obvious to substitute for Mero's barcode, a microchip in order to more conveniently register a trading card.

8. Claims 15 and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Mero et al. as applied to claim 1 above, and further in view of (Pearson et al. or Peppel).

Peppel teaches that it is known in the trading card art register on-line baseball trading cards col. 7, lines 3-26.

Pearson et al. teaches that it is known in the trading card art to incorporate unique identifiers (bar code or magnetic stripe) to baseball trading cards, and register a selected team of nine baseball trading cards using a card reader 22 and a computer 12 in order to play a fantasy baseball game on a TV monitor 14.

In view of such teaching, it would have been obvious to modify Mero's game board and trading cards in order to play a fantasy baseball game on the internet.

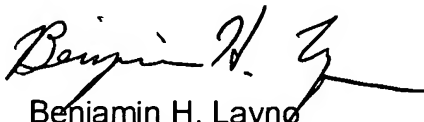
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Mero's game board would have simulated a baseball field, and Mero's trading cards would have represented real baseball players. This modification would have made Mero's game more attractive to baseball fans.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (703) 308-1815. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on (703) 308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


Benjamin H. Layno
Primary Examiner
Art Unit 3711

bhl
May 22, 2003